



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER 07/337,235	FILING DATE 04/15/87	FIRST NAMED APPLICANT FERRY	ATTORNEY DOCKET NO. D
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EXAMINER	
SHAY, R	
ART UNIT	PAPER NUMBER
338	6
DATE MAILED:	

This is a communication from the examiner in charge of your application.

01/31/90

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 12/4/89  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892. 2.  Notice re Patent Drawing, PTO-948.  
3.  Notice of Art Cited by Applicant, PTO-1449 4.  Notice of informal Patent Application, Form PTO-152  
5.  Information on How to Effect Drawing Changes, PTO-1474 6.

Part II SUMMARY OF ACTION

1.  Claims 1-13 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-13 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8.  Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are  acceptable;  not acceptable (see explanation).

10.  The  proposed drawing correction and/or the  proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved.  disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

Claim 1, as originally filed in Serial No. 726,767, is considered to be generic to the embodiments disclosed in that application of having a single piece or a plurality of pieces of material forming the enclosure. Therefore, Applicants' argument that the reissue claims requiring a plurality of pieces are narrower than the original broad claim is well taken.

The reissue declaration filed with this application is defective because it states that the discovery of the error was caused by the development of a new embodiment after the patent had issued. Inasmuch as the purpose of a Reissue Application is to correct errors that occur during prosecution, the question is raised as to how development after a patent issues of a new embodiment requiring a new material can point to an error in the prosecution of the patent.

Claims 1-3 are rejected as being based upon a defective reissue declaration under 37 CFR 1.175.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f)

and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 12-13 are rejected under 35 U.S.C. 103 as being unpatentable over Paschal in view of Beck.

Paschal discloses everything claimed with the possible exception of the properties of the elastic material. Paschal does state that his enclosure can be made from "flexible plastic material or any other suitable flexible material which is impervious to liquid". Beck discloses the use of rubber as the elastic material for a lubricant filled massaging device similar to the type disclosed by Paschal. In view of the teachings of Paschal and Beck, it would have been obvious to one of ordinary skill in the art to use rubber for the elastic material of Paschal because of its known suitability for such a use, rubber being disclosed by Applicants as meeting the claim limitations of the properties of the material.

It is noted that in the amendment filed on August 29, 1986 to add the recitation that the enclosure is made of a single piece of material, it was argued by Applicants on pages 5-6 that the added recitation is what differentiates the claimed invention from the Paschal device because Paschal uses two pieces of material, not meeting the limitation of a single piece. Removing this limitation, as is done by the reissue

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claims, makes the claims, once again, read on the  
Paschal device.

Any inquiry concerning this communication should be  
directed to Randy Shay at telephone number  
703-557-3125.

RS  
R. Shay:cm  
1/30/90

*R. Shay*  
RANDALL L. GREEN  
PRIMARY EXAMINER  
ART UNIT 338